

United States Patent and Trademark Office

Examiner: Chukwurah, N. Art Unit: 3721 Docket No.: 1969

In re:

Applicant: KRAENZLER, E. et al

Serial No.: 10/049,546

Filed: June 5, 2003

REPLY BRIEF

June 2, 2008

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sirs:

The Appellants submit the following for their Reply Brief in response to the Examiner's Answer dated April 2, 2008, and respectfully request consideration of same. The Appellants again request withdrawal of the rejections made and that the Application be placed in line for Allowance.

ARGUMENT

In his answer, the Examiner argues that Forderer et al disclose the invention as claimed “including the retaining element (50)”. The Examiner argues further that it is implicit in Forderer et al to provide a vibration-damping element for reducing vibration of the inner working parts of the tool. The Examiner acknowledges that Forderer’s vibration-damping element does not require the condition of “preventing a loosening of the grip part from the housing in the event of a damage to the elastic element” in order to reduce vibration of the inner working parts of the tool for the comfort of the user. Finally, the Examiner goes on to argue that Dorner et al show that it would be obvious to provide a screw in place of a non-screw retainer.

Again, the Appellants respectfully disagree with the Examiner’s analysis and position regarding the prior art.

Independent claim 16 of the present application defines that *the connection between the grip part and the mounting part by means of the elastic element is secured by at least one movable retaining element 20, 22, 28, 64, 112 that prevents a separation of the grip part from the housing if the elastic element is damaged and ensures control of the power tool via the grip part at all times.*

As argued previously, Forderer discloses a power tool with a handle 9 which is connected through an elastic, vibration-damping element 6 with a plug 41 as shown in Figures 2 and 3. A second plug 31 is inserted into an end section 30 on the vibration-damping element 6, to expand the vibration-damping element

6 radially outwardly and thereby to press the vibration-damping element 6 with its outer contour with a receding groove 21 form-lockingly into a corresponding inner contour with holding rib 25 of a housing 2. In the same way also the other end 46 of the vibration-damping element 6 is mounted on the handle 9. Here the plug 41 is inserted into the section 40 of the vibration-damping element 6 as shown in Figures 2 and 3 and described in column 2, line 59, to column 4, line 11. There is no contact between the plug 41 and the handle 9 there is no direct contact, since the section 40 of the vibration-damping element 6 surrounds the plug and therefore is located between it and the handle 9. Both plugs 31, 41 are connected with one another through a ***coupling element 50***.

The configuration of the vibration-damping element 20, 21, 22, 23 of the patent to Forderer is substantially similar to the configuration disclosed in the patent to Dorner. However, here the sleeve 50 which serves for expansion of the elastic element is connected with an additional screw 55 on the machine.

In contrast to the patent to Forderer, the patent to Dorner does NOT disclose any **retaining element** for preventing the loss of the handle 4 from the motor system 2' in the event of failure of the vibration-damping element 20, 21, 22, 23.

In addition, Dorner's device does not provide the advantages of the present invention, namely that in the event the elastic element is damaged, a release of the handle from the machine housing is always reliably prevented, as specifically recited in independent claim 16. Rather, in Dorner, if the elastic element is torn, the handle separates from the machine part.

Contrary to the Examiner's position, the screw 50 in Dorner has NO retaining function, but instead serves **exclusively** for mounting of the machine-side plug 50.

In the present invention, the system provided for retaining must be completely independent from the system to be retained, since otherwise the breakdown of the system to be protected can influence the retaining system. The retaining element 20 because of its construction is completely independent from the condition of the elastic element 14. The retention of the handle 12 is guaranteed at all times.

In Forderer, the use of the plug which serves for expansion of the elastic element 14 is irrelevant in the present invention: indeed, auxiliary means and their mounting can be completely eliminated. In Forderer, the plug 41 in connection with the coupling 50 and the second plug 31 can operate as a retaining element only as long as the elastic element 22 is in a position to reliably hold the plug 41. This example shows the dependence of the plug 41 on the elastic element 22. Thus, Forderer shows an essentially different principle for holding a handle on a machine system than in the applicant's invention. The construction extends a partially functionality of the elastic element into the mounting region 30, 40.

Therefore, even if the practitioner were to study and combine the references to Forderer and Dorner as proposed by the Examiner, such a combination would not provide a person of ordinary skill in the art with any different knowledge or suggestion, since the principles of both patents are

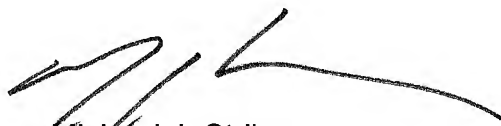
identical. In fact, Dorner **even more completely** dispenses with the retaining element.

Again, the cited reference combination provides with no suggestion that would lead to the present invention, since both damping systems disclosed in Forderer and Dorner have a totally different construction and operation than that of the present invention.

It is respectfully submitted that since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in MPEP section 2143.01. Please note also that the modification proposed by the Examiner **would change the principle of operation of the prior art**, so that also for this reason the references are not sufficient to render the claims prima facie obvious (see the last paragraph of the aforementioned MPEP section 2143.01).

In view of the foregoing discussion, it is respectfully requested that the Honorable Board of Patent Appeals and Interferences overrule the final rejection of claims 16-17, 19-20, 22-26, 28 and 33-39 over the cited art, and hold that Appellants' claims be allowable over such art.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

Michael J. Striker
Attorney for Applicant
Reg. No.: 27233

103 East Neck Road
Huntington, New York 11743
631-549-4700